

### III. REMARKS

Claims 2, 4, 10, 12, 13, and 23-25 are cancelled. Claim 3 has been amended to provide a specific range of sequence identity with SEQ ID 58 from 90-100%, support for which can be found on page 18 of the specification. Claims 5, 11, and 18 have been amended to reflect the cancellation of claims 2, 4 and 8.

#### *1. Rejections under 35 U.S.C. § 112*

##### **A. 35 U.S.C. § 112, second paragraph**

On page 2-3 of the Office Action, the Office rejected claims 10, 12, and 13 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10, 11, and 13 have been cancelled.

##### **B. Claims 3, 5-7, 11, 18, and claim 23-25 have sufficient written description**

On page 3-6, the Office rejects claims 2-7, 10-13, 18, and claim 23-25 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Claims 2, 10, 12-13, and 23-25 have been cancelled.

##### *1. Vas-Cath is distinguishable from and not applicable to the present application*

The Office cites *Vas-Cath Inc. v. Mahurkar*, 19USPQ2d 1111 (Fed. Cir. 1991). The patent at issue in *Vas-Cath* contained a claim with a range limitation that did not follow from the diagrams presented in the specification. *Vas-Cath* is distinguishable from the present application because the present Applicants clearly give the range of identity in the specification and the original claim.

##### *2. Fiers is distinguishable from and not applicable to the present application*

The Office also cites *Fiers v. Revel*, 984 F2d 1164 (Fed. Cir. 1993). The claims at issue in *Fiers* did not describe any nucleic acid sequence structure, which the court found to be inadequate written description because "conception of a

substance claimed per se without reference to a process requires conception of its structure, name, formula, or definitive chemical or physical properties.” Fiers at 1169. The present case is distinguishable from Fiers because it involves a specific nucleic acid sequence, and a defined range of identity.

*3. Amgen is distinguishable from and not applicable to the present application*

The Office also cites *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991). In *Amgen*, the enablement of the claimed invention was challenged because the relevant claims were defined by its biological characteristics rather than its structure. In the instant application, the claims do not contain limitations to biological characteristics, but instead are directed to the sequence itself, unlike the *Amgen* claims. Therefore, *Amgen* is distinguishable.

*4. Fiers is distinguishable from and not applicable to the present application*

The Office also cites *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF’s were found to lack written description for the broad class, because the specification only provided bovine sequence. The instant application is distinguishable because Applicants have provided a specific nucleic acid sequence and a range of identity. This range of identity is the written description of other sequences that fall within the scope of the claim. Therefore, *Fiddes* is not analogous to the present invention.

**C. Claims 1, 3, 5-7, and 18 are enabled.**

On pages 6-12, the Office rejects claims 1-7, 10-13, 18, 23-25, 28 and 29 under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains...to make and/or use the invention. Claims 2, 10, 12-13, and 23-25 have been cancelled.

Applicants point out that the claims as currently amended are directed to compositions of matter. Specifically, the nucleic acids of the current claims

would not hybridize to the non-OA targets identified by the Office. Therefore, the claims as presently amended are enabled.

*2. Rejections under 35 U.S.C. § 102*

A. On page 13 of the Office Action, claims 10, 12, and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jacobs *et al* (WO 98/45436). Claims 10, 12, and 13 have been cancelled.

B. On page 14 of the Office Action, claims 10, 12, and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Slade *et al*. Claims 10, 12, and 23-25 have been cancelled.

*3. Rejections under 35 U.S.C. § 103.*

**A. Amended claims 3, 5, and 7 are not obvious**

On page 15 of the Office Action, the Office rejected Claims 2-5, 7, 10-12, 18 and 23-25 under 35 U.S.C. § 103 (a) over Strausberg *et al.*, in view of Maniatis. Applicants have cancelled claims 2, 8, 10, 12-13, and 23-25.

Claim 3 as currently amended is directed to a nucleic acid exhibiting a percentage identity of between 90% to 100% with SEQ ID 58. The sequence given in Strausberg is not sufficiently similar to fall near the scope of this claim. Further, there is no motivation in the Strausberg sequence to identify the sequences of the present invention. Therefore, Claims 3, 5, and 7 are non-obvious.

In view of the foregoing amendments and remarks, it is submitted that all claims now active in the present application are in condition for allowance.

If the Office has any further comments or concerns, the Examiner is welcome to contact Applicants at the number below.

Respectfully submitted,

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